

REMARKS

Claims 8 and 9 are pending in the present application. Claims 8 and 9 are herein amended. Claims 1, 2, 6 and 7 are herein cancelled. No new matter has been entered.

Rejections under 35 USC §102(b)

Claims 1, 6 and 8 were rejected under 35 USC §102(b) as being anticipated by Deng et al. (U.S. Patent No. 5,980,977).

Claims 1 and 6 have been cancelled. Thus, the rejection of these claims has become moot. Also, claim 8 have been amended.

Responding to Applicants' previous response, the Examiner alleged as follows:

2. Applicant's arguments filed 5/13/2009 have been fully considered but they are not persuasive. Amended Independent claims 1, 6, and 8 recite the manner in which a claimed apparatus is **intended to be employed** and does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex Parte Masham, 2 USPQ F.2d 1647 (1987).

3. In regards to distinguishing between battery or cell and fuel cell.

A battery or cell is a container filled with substances that produce an electric current by chemical action.

A fuel cell is an electrochemical conversion device, which produces electricity from converting chemical energy through a chemical action.

In giving claim 8, the broadest reasonable interpretation then one would arrive at a cell or battery being an electrochemical conversion device producing electricity from chemical action. With this interpretation in mind, we arrive at the same definition or function of a fuel cell which is an electrochemical conversion device, which produces electricity from converting chemical energy through a chemical action.

(Office Action, page 2, items 2 and 3). However, claim 8 recites the structure of the membrane electrolyte assembly. Therefore, the difference is NOT **the manner in which a claimed**

apparatus is intended to be employed but **structural elements** which patentably distinguish over the prior art references.

Claim 8 recites “membrane electrolyte assembly for a fuel cell, comprising: an electrode including an oxygen reduction electrode catalyst comprising an oxynitride containing Ta, wherein atomic ratio of (tantalum):(oxygen):(nitrogen) is $(1\pm0.1):(1\pm0.1):(1\pm0.1)$; and an acidic electrolyte contacting said oxygen reduction electrode catalyst,” and “wherein said oxygen reduction electrode catalyst having an oxygen reduction catalytic activity at a potential of 0.4 V or higher relative to the reversible hydrogen electrode potential in said acidic electrolyte.”

Deng et al. does not discuss a fuel cell at all. Regarding a battery, Deng et al. describes as follows:

The thin layer metal oxynitride covered-substrate is useful for **electrical energy storage** as an electrode in a **capacitor** or **battery** configuration.

The present invention generally relates to an energy storage device, and more particularly to a **bipolar double layer capacitor-type energy storage device**, and to improved methods for manufacturing the same.

(Deng et al., column 1, lines 32-39). Deng et al. does not clearly describe the kind of battery it refers. From “**electrical energy storage** as an electrode in a **capacitor** or **battery** configuration,” it would be reasonable for a person skilled in the art that the term “battery” indicates rechargeable battery or secondary battery. The word “battery” mostly appears in Deng et al. as “capacitor or battery” without any further explanation. Another descriptions referring to “battery” discuss recharging (see Deng et al., column 62, lines 8-40). Thus, nothing in Deng et al. indicates a fuel battery which uses the oxygen reduction electrode which means a cathode.

Although the terms “cell” and “battery” are synonymously used, a fuel cell is completely different from a rechargeable battery.

Thus, there is no reason for a person having ordinary skill in the art to combine the electrode disclosed in Deng et al. with “a membrane electrolyte assembly for a fuel cell,” or “an acidic electrolyte contacting said oxygen reduction electrode catalyst,” as recited in claim 8.

For at least these reasons, claim 8 patentably distinguishes over Deng et al.

Rejections under 35 USC §103(a)

Claims 2, 7 and 9 were rejected under 35 USC §103(a) as being obvious over Deng et al. (U.S. Patent No. 5,980,977) in view of Clerc et al. (U.S. Patent No. 6,190,802).

Claims 2 and 7 have been cancelled. Thus, the rejection of these claims has become moot.

Claim 9 depends from claim 8. Because claim 8 patentably distinguishes over Deng et al., claim 9 also patentably distinguishes over Deng et al. for at least the same reasons discussed above.

Clerc et al. has been cited for allegedly disclosing a transition metal based ceramic doped with metals and/or metal oxide which is an electronically conductive powder. This ceramic is used for cathodes for rechargeable lithium batteries. Such disclosure of Clerc et al., however, does not remedy the deficiencies of Deng et al discussed above.

For at least these reasons, claim 9 patentably distinguishes over Deng et al. and Clerc et al.

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Art Unit: 2818

Amendment under 37 CFR §1.111
Attorney Docket No.: 062485

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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